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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/070,894

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Shinichiro Nagata

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2753

7590

06/08/2006

Allan Ratner
Ratner & Prestia
One Westlakes Berwyn Suite 301
PO Box 980
Valley Forge, PA 19482-0980

EXAMINER

BATURAY, ALICIA

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,894

Applicant(s)

NAGATA ET AL.

Examiner

Alicia Baturay

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the amendment filed 30 March 2006.
2. Claims 1-4, 6-9, 11-14 and 37-40 were amended.
3. Claims 15-36 and 41-94 were cancelled.
4. Claims 1-14 and 37-40 are pending in this Office Action.

Response to Amendment

5. The objection to the title was addressed and is withdrawn.
6. The rejection of claims 1-14 and 37-40 under 35 U.S.C. § 112, 2nd paragraph regarding indefiniteness remains outstanding.
7. The rejection of claims 37-40 under 35 U.S.C. § 112, 2nd paragraph regarding indefiniteness has been addressed and is withdrawn.
8. Applicant's amendments and arguments with respect to claims 1-14 and 37-40 filed on 30 March 2006 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 1-14 and 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. It is unclear how “after a predetermined time duration for *allowing* said user to terminate said telephone call,” a user could then register a change of email address if the user is no longer connected to the system. Appropriate correction is required. Additionally, use of the word ‘allowing’ means that the steps following ‘allowing’ are not prevented from occurring, not that they are actually occurring.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-4, 6-9, 11-14 and 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Shibuya (U.S. 6,847,703).

13. With respect to claim 1, Shibuya teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Shibuya, Fig. 3; col. 8, lines 9-14); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is

registered or unregistered (Shibuya, col. 10, line 64 – col. 11, line 6); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for allowing the user to notify an e-mail address (Shibuya, col. 9, lines 43-46); when the telephone number of the caller is determined as registered, after a predetermined time duration for allowing the user to terminate the telephone call (Shibuya, col. 9, lines 7-13), carrying out registration change guidance for allowing the user to notify a new e-mail address for registration change (Shibuya, col. 9, lines 43-65); and when the user has terminated the telephone call before the elapse of the predetermined time duration, searching the data base on the basis of the telephone number of the caller, and thereby transmitting e-mail information to the obtained e-mail address (Shibuya, col. 9, lines 23-30).

14. With respect to claim 2, Shibuya teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Shibuya, Fig. 3; col. 8, lines 9-14); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Shibuya, col. 10, line 64 – col. 11, line 6); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for allowing the user to notify an e-mail address (Shibuya, col. 9, lines 43-46); when the telephone number of the caller is determined as registered, after a predetermined time duration for allowing the user to terminate the telephone call (Shibuya, col. 9, lines 7-13),

carrying out registration change guidance for allowing the user to notify a new e-mail address for registration change (Shibuya, col. 9, lines 43-65); and when the telephone number of the caller is determined as registered, regardless of whether the registration change guidance has not yet begun, has already begun, or has already completed, when the user has terminated the telephone call, searching the database on the basis of the telephone number of the caller, and thereby transmitting e-mail information to the obtained e-mail address (Shibuya, col. 9, lines 23-30).

15. With respect to claim 3, Shibuya teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Shibuya, Fig. 3; col. 8, lines 9-14); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Shibuya, col. 10, line 64 – col. 11, line 6); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for allowing the user to notify an e-mail address (Shibuya, col. 9, lines 43-46); when the telephone number of the caller is determined as registered, after a predetermined time duration for allowing the user to terminate the telephone call (Shibuya, col. 9, lines 7-13), carrying out registration change guidance for allowing the user to notify a new e-mail address for registration change (Shibuya, col. 9, lines 43-65); and when the telephone number of the caller is determined as registered, and when the registration change guidance is guidance for

allowing the user to notify a new e-mail address for registration change during the voice communication of the telephone call, if the new e-mail address for registration change is not yet notified at the time when the user has terminated the telephone call, searching the data base on the basis of the telephone number of the caller and thereby transmitting e-mail information to the obtained e-mail address (Shibuya, col. 9, lines 23-30), in contrast, if the new e-mail address for registration change is already notified at the time when the user has terminated the telephone call, not transmitting the e-mail information to the e-mail address older than the notified e-mail address (Shibuya, col. 9, lines 43-65).

16. With respect to claim 4, Shibuya teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Shibuya, Fig. 3; col. 8, lines 9-14); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Shibuya, col. 10, line 64 – col. 11, line 6); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for allowing the user to notify an e-mail address (Shibuya, col. 9, lines 43-46); when the telephone number of the caller is determined as registered, after a predetermined time duration for allowing the user to terminate the telephone call (Shibuya, col. 9, lines 7-13), carrying out registration change guidance for allowing the user to notify a new e-mail address for registration change (Shibuya, col. 9, lines 43-65); when the telephone number of the

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caller is determined as registered, and when the user has terminated the telephone call, searching the database on the basis of the telephone number of the caller, and thereby transmitting e-mail information to the obtained e-mail address (Shibuya, col. 9, lines 23-30); and when the telephone number of the caller is determined as registered, and when the registration change guidance is guidance for allowing the user to notify a new e-mail address for registration change during the voice communication of the telephone call, if the new e-mail address for registration change is already notified at the time when the user has terminated the telephone call, not transmitting the e-mail information to the e-mail address older than the notified e-mail address (Shibuya, col. 9, lines 43-65).

17. Claims 6-9, 11-14, and 37-40 do not teach or define any new limitations above claims 1-4 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibuya and further in view of Dosani et al. (U.S. 6,529,591).

Shibuya teaches the invention substantially as claimed including a portable communication terminal capable of informing the other of a user's situation properly by an electronic mail or the like, under the situations where voice communication is difficult for the user of the portable information terminal, and provide a communication system service using the same portable communication terminal (see Summary of the Invention).

20. With respect to claim 5, Shibuya teaches the invention described in claim 1, including an information distribution method where:

E-mail information is transmitted depending on the telephone numbers of the telephone destinations (Shibuya, col. 9, lines 23-30).

Shibuya does not explicitly teach storing an association between the telephone number of the caller of the telephone call and the telephone number of the telephone destination in a database.

However, Dosani teaches when there are a plurality of telephone destinations and, at each time when any one of the telephone destinations receives a telephone call from the user, the telephone number of the caller of the telephone call and the telephone number of the telephone destination having received the telephone call are stored in a form corresponded to each other in a second database for a predetermined time duration (Dosani, col. 3, line 64 – col. 4 line 8); and when the telephone number of the caller is determined as unregistered, and when the e-mail address has been already notified according to the predetermined method on the basis of the guidance, the telephone number of the telephone destination corresponding to the telephone number corresponding to the notified e-mail address is identified by searching

the second database (Dosani, col. 7, lines 1-17), whereby e-mail information depending on the telephone number of the telephone destination is transmitted to the notified e-mail address (Dosani, col. 8, lines 35-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shibuya in view of Dosani in order to enable storing an association between the telephone number of the caller of the telephone call and the telephone number of the telephone destination in a database. One would be motivated to do so in order to avoid long-distance and/or airtime charges that would occur if the called independent system had to answer a call made from a client to obtain its identification information.

21. Claim 10 does not teach or define any new limitations above claim 5 and therefore is rejected for similar reasons.

Response to Arguments

22. Applicant's arguments filed 30 March 2006 have been fully considered, but they are not persuasive for the reasons set forth below.

23. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
June 1, 2006


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER